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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/268,412	03/15/99	SILVERA	A 31045-7

QM12/1103
MITCHELL SILBERBERG & KNUPP
11377 WEST OLYMPIC BOULEVARD
LOS ANGELES CA 90064

EXAMINER	
MOHANDESI, J	
ART UNIT	PAPER NUMBER

3728
DATE MAILED: 11/03/00

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 09/268,412
Filing Date: March 15, 1999
Appellant(s): Albert Silvera

Joseph G. Swan
For Appellant

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EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed October 16, 2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that each of seven groups of claims do stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,421,765	Lehmann et al.	6-1995
5,290,043	Vidinic	5-1994

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5,136,726	Kellin et al.	8-1992
764,103	Ponataro	11-1933

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The examiner will treat references in the application to stick-on tattoos as relating merely to adhesive-backed prints or stickers having decorative designs and/or legends which are commonly adapted to be placed on a toy, child or apparel. See instant specification, page 6, lines 28-30.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 5, 7, 8-9 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over Lehmann et al. (5,421,765) in view of Vidinic (5,290,043). Lehmann '765 teaches substantially all the limitations of the claims such as simulated tattoos/stickers **32** comprising a front image surface **32a** which carries the visible design of the simulated tattoos/stickers, and an adhesive backing means **32b** adapted to be removably secured to different parts of either or both a toy element means **12** and or a child. The back of the simulated tattoos/stickers are moistened and then placed on and/or

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removed from the hair or the surface or clothing of the toy element means 12 or the child. Contrary to Applicant's argument, the stick-on tattoos use in the U.S. Patent to Lehmann appear to be the same as the tattoos used in the present invention, despite Lehmann's characterization to the contrary. The simulated tattoos of Lehmann '765 are non-toxic water-soluble adhesive-backed prints having decorative designs and legends simulating play markings or play tattoos adapted to be placed on either or both the toy element and/or the child, or transferred between them. The adhesive- tattoos do not require a separate adhesive to adhere to surface and are believed to adhere inherently when the print gets wet. However, if there is any doubt that these tattoos are different, there is nothing unobvious about using any of the well known tattoos such as those in the instant specification page 7, lines 1-3, instead of the simulated tattoos of Lehmann removably secured to a body or article of footwear. Lehmann '756 does not appear to specifically teach providing simulated tattoos/stickers on different parts of the shoe. Providing simulated tattoos/stickers on different parts of the shoe, is so old and conventional as to hardly require citation of a reference, but Vidinic '043 is provided merely as an example of this common practice. Therefore, it would have been obvious to one having ordinary skill in the art and in view of Vidinic '043 to provide stimulated tattoos/stickers on shoes to decorate them as one pleases. With respect to claims 2 and 9 which further limits the material of the stimulated tattoos/stickers, it would have been obvious to one having ordinary skill in the art to modify and/or alter the shape and material of simulated tattoos/stickers to provide different designs and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of sizes, shapes or materials. It has been held to be

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within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

3. Claims 1-2, 4-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann et al. (5,421,765) in view of Kellin et al. (5,136,726). Lehmann '765 substantially teaches all the limitations of the claims such as simulated tattoos/stickers **32** comprising a front image surface **32a** which carries the visible design of the simulated tattoo, and an adhesive backing means **32b** adapted to be removably secured to different parts of either or both a toy element means **12** and a child. The back of the simulated tattoos/stickers are moistened and then placed on and/or removed from the hair or the surface or clothing of the toy element means **12** or the child. The adhesive-backing means **32b** is non-toxic, non-permanent and preferably water-soluble, with moistening for application to and removal from toy or child by atomized water spray from the moisturizing means **16**. Contrary to Applicant's argument, the stick-on tattoos use in the U.S. Patent to Lehmann appear to be the same as the tattoos used in the present invention, despite Lehmann's characterization to the contrary. The simulated tattoos of Lehmann '765 are non-toxic water-soluble adhesive-backed prints having decorative designs and legends simulating play markings or play tattoos adapted to be placed on either or both the toy element and/or the child, or transferred between them. The adhesive-tattoos do not require a separate adhesive to adhere to surface and are believed to adhere inherently when the print gets wet. However, if there is any doubt that these tattoos are different, there is nothing unobvious about using any of the well known tattoos such as those in the instant specification page 7, lines 1-3, instead of the simulated tattoos of Lehmann removably secured to a

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body or article of footwear. Lehmann '765 does not appear to teach placing simulated tattoos/stickers on shoes. Kellin '726 teaches placing one or more of detachable decorative elements on different articles of apparel such as boots, shoes, cap, belt and backpacks as shown in Figures 1,2, 6, 8 and 9 embodiments. Therefore, it would have been obvious to one having ordinary skill in the art and in view of Kellin '726 to provide simulated tattoos/stickers to different apparels such a boots, shoes and caps. With respect to claims 4, 6-7 which further limit the shape, size make of the shoes and location on the shoe the simulated tattoos/stickers is placed, this would be entirely a design choice depending on the type, shape, size of the shoe and the users choice as where to place the tattoo on the shoes. With respect to claims 2 and 9 which further limits the material of the stimulated tattoos/stickers, it would have been obvious to one having ordinary skill in the art to modify and/or alter the shape and material of simulated tattoos/stickers to provide different designs and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of sizes, shapes or materials. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

4. Claim 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penataro (764,103) in view of Lehmann et al. (5,421,765). Penataro '103 teaches placing an ornamental strip in a recess with a smooth surface on a shoe. Penataro '103 does not appear to teach the ornamental strip to be a stick-on simulated tattoos/stickers. Lehmann '765 teaches stick-on simulated tattoos/stickers **32** with an adhesive backing means **32b** adapted to be removably secured to different

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parts of either or both a toy element means **12** and a child. Therefore, it would have been obvious to one having ordinary skill in the art and in view of Lehmann '765 to provide simulated tattoos/stickers in the recess area of Penataro '103 shoe as an aesthetic choice. With respect to claims 13-14 and 17 which further limit the shape, size of the recess portion and smooth portion, it would have been obvious to one having ordinary skill in the art to modify and/or alter the shape and size of the recess portion and smooth portion in order to fit the decorative strip more securely and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of sizes or shapes. With respect to claims 15-16 and 19 which further limit the material of smooth portion and simulated tattoos/stickers, it would have been obvious to one having ordinary skill in the art to modify and/or alter the material of the smooth portion and the simulated tattoos/stickers depending on their intended use and for ease of manufacturing and cost and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of materials. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With respect to claim 18, whether the smooth portion is stitched into the outer portion of the shoe or any other art recognized equivalent is an obvious matter of choice, such as easier and cheaper manufacturing.

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(11) Response to Argument

Applicant's arguments filed October 16, 2000 have been fully considered but they are not persuasive. Contrary to Applicant's argument, the stick-on tattoos use in the U.S. Patent to Lehmann appear to be the same as the tattoos used in the present invention, despite Lehmann's characterization to the contrary. The simulated tattoos of Lehmann '765 are non-toxic water-soluble adhesive-backed prints having decorative designs and legends simulating play markings or play tattoos adapted to be placed on either or both the toy element and/or the child, or transferred between them. The adhesive-tattoos do not require a separate adhesive to adhere to surface and are believed to adhere inherently when the print gets wet. However, if there is any doubt that these tattoos are different, there is nothing unobvious about using any of the well known tattoos such as those in the instant specification page 7, lines 1-3, instead of the simulated tattoos of Lehmann removably secured to a body or article of footwear as taught by Lehmann and Kellin '726.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kellin '726 teaches placing one or more of detachable decorative elements on different articles of apparel such as boots, shoes, cap, belt and backpacks as shown in Figures 1, 2, 6, 8 and 9 embodiments. Therefore,

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it would have been obvious to one having ordinary skill in the art and in view of Kellin '726 to provide the stimulated tattoos/stickers of Lehmann '765 to different apparels such a boots, shoes and caps. In response to applicant's argument that stick-on tattoos adhere better to smooth surfaces, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Paul T. Sewell
Supervisory Patent Examiner
Group 3700

JMM
November 1, 2000



Ted Kavanaugh
Primary Examiner

MITCHELL, SILBERBERG & KNUPP LLP
11377 West Olympic Boulevard
Los Angeles, CA 90064